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**In The United States Patent and Trademark Office
On Appeal From The Examiner To The Board
of Patent Appeals and Interferences**

In re Application of: Ranjit N. Notani

Serial No.: 09/415,052

Date Filed: October 8, 1999

Group Art Unit: ~~2161~~ 3629

Examiner: Pierre E. Elisca

Confirmation No.: 4247

For: System and Method for Performing a Business Process
in a Multi-Enterprise, Collaborating Network

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Willie Jiles

Willie Jiles

Date: August 27, 2004

Appeal Brief

Appellant has appealed to the Board of Patent Appeals and Interferences ("Board") from the decision of the Examiner mailed April 15, 2004, finally rejecting all pending Claims 2-8, 10-18, and 20-44. Appellant filed a Notice of Appeal on April 27, 2004. Appellant respectfully submits this Appeal Brief in triplicate with the statutory fee of \$330.00, along with a two-month extension fee of \$420.00.

Real Party in Interest

This Application is currently owned by i2 Technologies US, Inc., as indicated by an Assignment recorded on June 28, 2001, from the sole inventor (Ranjit N. Notani) to i2 Technologies, Inc., in the Assignment Records of the United States Patent and Trademark Office at Reel 010313, Frames 0237-0239, and an Assignment recorded on September 4, 2001, from i2 Technologies, Inc. to i2 Technologies US, Inc., in the Assignment Records of the United States Patent and Trademark Office at Reel 012037, Frames 0435-0446.

Related Appeals and Interferences

There are no known appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision regarding this Appeal.

Status of Claims

Claims 2-8, 10-18, and 20-44 are pending in this Application, stand rejected pursuant to a final Office Action mailed April 15, 2004, and are all presented for appeal. All pending claims are shown in Appendix A.

Status of Amendments

All amendments submitted by Appellants were entered by the Examiner before the issuance of the final Office Action mailed April 15, 2004.

Summary of Invention

In certain embodiments, the present invention includes a system 10 for performing a business process that includes clients 12a-12e coupled to each other using communication links 14. Clients 12 perform particular business processes with each other using corresponding business applications 16 that may be categorized according to varying degrees of versions 18. In general, higher level versions 18 of business applications 16 may understand, meaningfully interact with, or otherwise support lower level versions 18 of business applications 16. In this respect, a higher level version 18 of a business application 16 can perform the associated business process according to the functionality of any lower level version 18 of the business application 16. Therefore, a first client 12 seeking to perform a particular business process with a second client 12 using a business application 16 determines which client 12 executes the particular business process using the higher level

version 18 of the business application 16. The determined client 12 then performs the business process in a manner supported by the lower level version 18 of the business application 16. (*See Page 7, Lines 2-23*)

A business process comprises any transaction between clients 12 that involves the exchange of information using a business application 16. A particular example of a business process is an "Order Purchasing" business process; however, it should be understood that system 10 supports any appropriate type of business process in any suitable business industry. For example, system 10 supports business processes in the consumer goods manufacturing industry (e.g., order purchasing, accounting, procurement, shipping, delivery, replenishment, inventory management, marketing automation, and supply chain integration); the distribution industry (e.g., tracking, shipping, and routing); the financial services industry (e.g., electronic funds transfer, electronic payment systems, security systems); and any suitable type of business process in any other business industry. (*See Page 8, Lines 5-21*)

Each business application 16 comprises a software computer program written in any suitable computer language that may be compiled based on the instructions of a selected computer operating system associated with a corresponding client 12. In general, each business application 16 executes to perform a particular business process and may be categorized using versions 18. Some versions 18 of a particular business application 16 are generally referred to as more robust, more advanced, or otherwise higher than other versions 18 of the business application 16 if they provide enhanced functionality or services in performing the associated business process. The particular versions 18 of a business application 16 may be indicated using version identifiers. (*See Page 9, Lines 1-15*)

A particular advantage of system 10 is that higher level versions 18 of a business application 16 exhibit "backward compatibility" that allows them to understand, meaningfully interact with, or otherwise support lower level versions 18 of the business application 16. For example, higher level versions 18 of a business application 16 can operate using files, message formats, protocols, data structures, commands, and other functionality associated with lower level version 18 of business application 16. Therefore, higher level versions 18 of a business application 16 may exhibit backward compatibility by

performing an associated business process according to the functionality of the lower level versions 18 of the business application 16. (*See* Page 9, Lines 16-29)

Clients 12 of system 10 may perform different activities depending upon the particular business process to be executed. For example, during the execution of a order purchasing business process, respective clients 12 may perform buyer and/or seller activities, and are therefore generally referred to as buyer clients 12 and seller clients 12. A further technical advantage provided by system 10 is that business applications 16 exhibit "bidirectional executability" such that a particular business application 16 may execute a business process that, from a business standpoint, it does not initiate itself. For example, a portion of the order purchasing business process may involve a buyer client 12 communicating a purchase order to a seller client 12. From a business standpoint, this business process is initiated by the buyer client 12, so that the buyer client 12 may be referred to as a "business initiator." However, the higher level version 18 of business application 16 may execute the order purchasing business process even if it is maintained by a seller client 12 rather than by the buyer client 12 that is the business initiator. (*See* Page 9, Line 35 - Page 10, Line 19)

In operation of an example embodiment of system 10, clients 12 execute business applications 16 to perform one or more business processes in system 10. A first client 12, such as a business initiator seeking to perform a particular business process with a second client 12, determines which client 12 maintains a higher level version 18 of the appropriate business application 16 used to execute the business process. In one embodiment, the first client 12 communicates a request to identify the version 18 of the business application 16 maintained by the second client 12. In another embodiment, the first client 12 stores information identifying the version 18 of the appropriate business application 16 maintained by each of its partner clients 12, such as the second client 12, to perform the particular business process. (*See* Page 10, Line 26 - Page 11, Line 8)

The client 12 having the higher level version 18 of the appropriate business application 16 exhibits "backward compatibility" and/or "bidirectional executability" to execute the particular business process with the other client 12. In particular, the client 12 having the higher level version 18 of the business application 16 performs the particular

business process in a manner supported by the lower level version 18 of the business application 16 maintained by its partner client 12. In this respect, the business process is executed between clients 12 maintaining different versions 18 of the business application 16. (See Page 11, Lines 12-22)

A technical advantage provided by system 10 is that because business applications 16 support "bi-directional executability" and "backward compatibility," a particular client 12 can upgrade the version 18 of a particular business application 16 without negatively impacting any other client 12 in system 10. To illustrate an example of this advantage, client 12a performs a particular business process using a first version 18 of an appropriate business application 16. The first version 18 of business application 16 may comprise the lowest level version 18 maintained by any of clients 12 with which client 12a performs the indicated business process. Clients 12b, 12c, and 12d execute the business process using a second version 18 of the appropriate business application 16 that is a higher version than that maintained by client 12a. Furthermore, client 12e performs the business process using a third version of business application 16 that is a higher version 18 than those maintained by any of clients 12a-12d. (See Page 11, Line 32 - Page 12, Line 15)

In this example, if client 12c is a business initiator seeking to perform the business process with client 12a, client 12c determines that it maintains the higher level version 18 of the appropriate business application 16. As a result, client 12c exercises control in executing the business process with client 12a according to the functionality of the lower level version 18 of the business application 16 maintained by client 12a. (See Page 12, Lines 16-23)

If client 12c is a business initiator seeking to perform the business process with either of clients 12b or 12d, client 12c determines that it maintains the same version 18 of business application 16 as clients 12b and 12d. In this situation, the business application 16 of business initiator, such as client 12c, generally executes the business process and therefore does not exhibit bidirectional executability in this particular situation. Furthermore, because the versions 18 of business application 16 are the same among clients 12b, 12d, and 12c, the business application 16 of client 12c does not exhibit backward compatibility in this particular situation. (See Page 12, Lines 24-36)

If client 12c is a business initiator seeking to perform the business process with client 12e, client 12c determines that client 12e maintains the higher level version 18 of business application 16. As a result, client 12e exercises control in executing the business process according to the functionality of the lower level version 18 of the business application 16 maintained by client 12c. In each of the above-identified arrangements of partner clients 12, the business process is executed in a manner supported by the business applications 16 of each client 12 regardless of the particular version 18 maintained by any given client 12. (See Page 13, Lines 1-12)

Assuming now that client 12c upgrades its version 18 of business application 16 from the second version 18 to a fourth version 18 that is a higher version than those maintained by clients 12a, 12b, 12d, or 12e. Client 12c now maintains the highest level version 18 of business application 16 among its partner clients 12. Clients 12b and 12d now maintain lower versions 18 of business application 16 than client 12c. Therefore, system 10 grants control to client 12c to initiate and execute the business process with either of clients 12b or 12d according to the functionality of the lower level version 18 of the business application 16 maintained by clients 12b and 12d. Because client 12c maintains a fourth version 18 of business application 16 and client 12e maintains a third version 18 of business application 16, client 12c receives control to execute the business process according to the lower level version 18 of the business application 16 maintained by client 12e. The situation between clients 12c and 12a remains unchanged because client 12c still maintains a higher level version 18 of business application 16 than client 12a. (See Page 13, Line 13 - Page 14, Line 2)

None of clients 12a, 12b, 12d, or 12e are impacted by the upgrade of business application 16 by client 12c. In particular, none of clients 12a, 12b, 12d, or 12e need to upgrade their respective business applications 16 in order to perform a business process with client 12c even though client 12c upgraded its version 18 from a second version 18 to a fourth version 18 of business application 16. This is because client 12c executes the business process with respect to each of clients 12a, 12b, 12d, and 12e, and because business application 16 of client 12 exhibits backward compatibility that allows it to execute the business process according to the functionality of any lower level versions 18 of the business

application 16, such as the business applications 16 of clients 12a, 12b, 12d, and 12e. (*See* Page 14, Lines 3-17)

Even if client 12c is not the "business initiator" of the business process, the business application 16 of client 12c can still execute the business process because it supports bidirectional executability. Business applications 16 of clients 12b, 12d, and 12e may operate differently after the upgrade of business application 16 by client 12c because the control of the business process is no longer with them, but they do not need to be upgraded, or modified in any manner, in order to perform the business process with client 12c. Because a particular client 12 of system 10 may upgrade the version 18 of a particular business application 16 without negatively affecting any of its partner clients 12, system 10 is stable and scaleable. In particular, system 10 is not in a constant state of change so that system 10 is stable with respect to time. Furthermore, system 10 can support many clients 12 so that it is scaleable in terms of size. Moreover, many clients 12 provide back-end integration of business applications 16 to systems such as inventory, planning, ERP, and financial systems. The use of business applications 16 allows these systems to be preserved because business applications 16 may also be backward compatible with these systems. In this respect the back-end systems are generally shielded from upgrades to business applications 16. (*See* Page 14, Line 18 - Page 15, Line 5)

As illustrated in FIGURE 2 and described at least on Pages 15-16 of the Specification, a business process may comprise a business process module 30, a version identification module 32, and a status message module 34 for performing at least certain of the above-described functionality.

Statement of Issues

Are Claims 2-8, 10-18, and 20-44 patentable over U.S. Patent 5,911,776 to Guck ("Guck") in view of U.S. Patent 6,421,787 to Slaughter, et al. ("Slaughter") under 35 U.S.C. § 103(a)?

Grouping of Claims

Appellant has made an effort to group claims to reduce the burden on the Board. In the Argument section of this Appeal Brief, where appropriate, Appellant presents arguments as to why particular claims subject to a ground of rejection are separately patentable from other claims subject to the same ground of rejection.

Appellant has concluded that the claims may be grouped together as follows:

1. Group 1 may include independent Claims 6, 15, 25, and 44 and dependent Claims 18 and 28;
2. Group 2 may include dependent Claims 2, 10-11, and 20-21;
3. Group 3 may include dependent Claims 3, 12, and 22;
4. Group 4 may include dependent Claims 4, 13, and 23;
5. Group 5 may include dependent Claims 5, 14, and 24;
6. Group 6 may include dependent Claims 7, 16, and 26;
7. Group 7 may include dependent Claims 8, 17, and 27;
8. Group 8 may include dependent Claims 29, 34, and 39;
9. Group 9 may include dependent Claims 30, 35, and 40;
10. Group 10 may include dependent Claims 31, 36, and 41;
11. Group 11 may include dependent Claims 32, 37, and 42; and
12. Group 12 may include dependent Claims 33, 38, and 43.

Argument

The rejection of Claims 2-8, 10-18, and 20-44 under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Guck-Slaughter* combination is improper and should be reversed by the Board.

The Claims are Patentable over the Proposed *Guck-Slaughter* Combination

I. Overview

Claims 2-8, 10-18, and 20-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Examiner's proposed *Guck-Slaughter* combination. A copy of *Guck* is attached as Appendix B, and a copy of *Slaughter* is attached as Appendix C. Appellant

respectfully submits that the Examiner's proposed *Guck-Slaughter* combination fails to support the obviousness rejections of Claims 2-8, 10-18, and 20-44. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

II. Standard

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. *See* 35 U.S.C. § 103(a). Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed below, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted). Moreover, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or

suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However,

¹ Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to show a sufficient motivation in the prior art to combine the references that allegedly create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

III. Guck

Guck merely discloses a network providing a server using an object-database that enables an author to create and store an original document, as a source file with a first format. (Abstract) According to *Guck*, software in the database will provide multiple sets of shadow file-converter groups connected to the source file of the original document. *Guck* further

discloses that each shadow file-converter set enables the transformation of the original source file format into a particular other specific type of format. According to *Guck*, any client or user of the network can access and receive a copy of the original source document, which is automatically reformatted to match the requirements of the receiver's appliance. (Abstract) The portions of *Guck* on which the Examiner primarily relies merely disclose the use of shadow files and corresponding converters to allow an original source file to be transformed into other formats according to particular needs of requesting clients. (See Abstract; Column 1, Lines 24-30; Column 4, Lines 41-54; Column 4, Lines 66 - Column 5, Line 25)

IV. Slaughter

Slaughter discloses a highly available cluster message passing facility. The portion of *Slaughter* on which the Examiner primarily relies (indeed the only portion of *Slaughter* cited by the Examiner) merely discloses:

Network transport 328A performs the protocol functions over the links of data communicate link 112. In one embodiment, a TCP/IP protocol is used over data communication link 112. In other embodiments, other protocols may be implemented. For example, a faster protocol such as Low Latency Connectivity Layer (LLCL), Message Passing Interface (MPI), or Low Overhead Communication (LOCO) may be used.

(Column 10, Lines 8-15)

V. Group 1 (Claims 6, 15, 18, 25, 28, and 44)

Claims 6, 15, 18, 25, 28, and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these claims are clearly patentable over the proposed *Guck-Slaughter* combination. Thus, Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

Claims 6, 15, 18, 25, 28, and 44 are separately patentable from every other claim subject to the same ground of rejection. These claims recite limitations that are substantially different from limitations recited in other claims. In addition, claims excluded from Group 1

that are subject to the same ground of rejection and that depend on independent Claims 6, 15, and 25, respectively, recite patentable distinctions over the prior art beyond those recited in independent Claims 6, 15, and 25 and cannot be properly grouped with independent Claims 6, 15, and 25 for purposes of this Appeal.

Independent Claim 6 of the present application, for example, recites:

A system for performing a business process, comprising:
a first version of a business application identified using a first version identifier and executable by a first client to perform a business process, the first client being coupled to a second client using a communication link, a second version of the business application identified using a second version identifier being executable by the second client to perform the business process;
the first version of the business application operable to determine the first version identifier and the second version identifier and, if the first version is higher than the second version, to exercise control over execution of the business process;
the first version of the business application operable to allow the second version of the business application to exercise control over execution of the business process if the second version is higher than the first version.

The proposed *Guck-Slaughter* combination fails to disclose, teach, or suggest various limitations as specifically recited in Claim 6.

For example, the proposed *Guck-Slaughter* combination does not disclose, teach, or suggest at least the following limitations recited in independent Claim 6:

- (1) first and second versions of a single business application being identified using first and second version identifiers, respectively, and being executable by first and second clients, respectively, to perform a business process; and
- (2) that the first version of the single business application is operable to:
 - (a) determine the first and second version identifiers;
 - (b) exercise control over execution of the business process if the first version of the single business application is higher than the second version of the single business application; and

(c) allow the second version of the single business application to exercise control over execution of the business process if the second version of the single business application is higher than the first version of the single business application.

The portions of *Guck* relied on by the Examiner merely disclose the use of shadow files and corresponding converters to allow an original source file to be transformed into other formats according to particular needs of requesting clients. (*See* Abstract; Column 1, Lines 24-30; Column 4, Lines 41-54; Column 4, Line 66 – Column 5, Line 25)

The Examiner equates: (1) "the process of enabling an author to create and store an original document or first document or first application" as disclosed in *Guck* against Appellant's recited first version of the single business application; and (2) "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" as disclosed in *Guck* against Appellant's recited second version of the single business application. (*See, e.g.*, final Office Action mailed April 15, 2004, Pages 3 and 7-9) First, Appellant notes that the original document disclosed in *Guck* cannot properly be equated with "a first application" as the Examiner suggests in the last two Office Action, much less equated with Appellant's recited first version of the single business application. Second, even assuming for the sake of argument that these processes could be equated with business applications, Claim 6 makes clear that the recited first and second versions executable by the first and second clients, respectively, are two versions of *the same business application* (i.e. "the business application") rather than two completely different business applications as the Examiner's argument requires.

Appellant respectfully submits that the Examiner has apparently failed to give proper weight and meaning to the limitations recited in Appellant's claims, as those limitations are specifically recited in Appellant's claims. In particular, the Examiner must give proper weight and meaning to Appellant's recited first and second versions of *the single business application* and the recited operations that the recited first and second versions of *the single business application* perform. During prosecution of the present application, Appellant repeatedly indicated his belief that the Examiner was not giving proper weight and meaning

to at least these limitations. (*See* Response mailed August 14, 2003 and Response mailed January 28, 2004)

Moreover, following the Examiner's reasoning, for *Guck* to be applied against Claim 6, "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) would need to be operable to:

- (1) determine a first version identifier for itself;
- (2) determine a second version identifier for "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Appellant's recited second version of the single business application);
- (3) exercise control over enabling "an author to create and store an original document, as a source file with a first format" (which the Examiner applies against Appellant's recited business process) if its version is higher than the version of "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Appellant's recited second version of the single business application); and
- (4) allow "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Applicant's recited second version of the single business application) to exercise control over execution of enabling "an author to create and store an original document, as a source file with a first format" (which the Examiner applies against Appellant's recited business process) if the version of "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Appellant's recited second version of the single business application) is higher than its version.

Appellant respectfully submits that, not only does the above make little if any sense, but the above is very plainly not disclosed, taught, or suggested in *Guck*, whether *Guck* is considered alone or in combination *Slaughter*. Appellant respectfully submits that there is no reasonable basis upon which to assert that "the process of enabling an author to create and store an original document or first document or first application," on the one hand, and "the

process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances," on the other hand, are two versions of *the same business application*. This was made abundantly clear above where Appellant carried the Examiner's assertion through the entirety of Appellant's independent Claim 6 and revealed the absurd and nonsensical result that would necessarily follow.

The Examiner acknowledges that *Guck* fails to disclose that the first version of the single business application is operable: (1) if the first version is higher than the second version, to exercise control over execution of the business process; and (2) if the second version is higher than the first version, to allow the second version of the single business application to exercise control over execution of the business process. (*See, e.g.*, final Office Action, Pages 3-4) Appellant respectfully notes that these elements acknowledged to be missing from the primary reference *Guck* constitute two of the three total elements in Appellant's independent Claim 6.

To attempt to account for these missing elements, the Examiner: (1) equates first and second user protocols with Appellant's recited first and second versions of the single business application, respectively; (2) cites a portion of the secondary reference *Slaughter* disclosing that a protocol faster than TCP/IP may be used for data communications (*See* Column 10, Lines 8-15); and (3) states that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the format conversion of *Guck* by including a faster protocol as taught by *Slaughter* because such modification would provide the format conversion of *Guck* with the enhanced necessary to have a faster network communication or business process" and that "a user with a faster protocol, should have control over the business process"² It is very difficult if not impossible to understand the nature of the Examiner's proposed modification of *Guck* or how such modification would be relevant to Appellant's claimed invention, but in any event, Appellant respectfully submits that the Examiner's conclusory assertion of obviousness is entirely insufficient to support an

² Appellant repeatedly included the following statements in each of Appellant's Responses to Office Actions in which this statement was made by the Examiner: "If 'common knowledge' or 'well known' art is being relied on or if Official Notice is being taken, Appellant respectfully requests that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. If personal knowledge is being relied on, Appellant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03." However, the Examiner has yet to produce any document or affidavit supporting this statement made by the Examiner.

obviousness rejection under 35 U.S.C. § 103(a) under the M.P.E.P. and governing Federal Circuit case law.

The Examiner provides the following purported motivation to combine these references: "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the format conversion of Guck by including a faster protocol as taught by Slaughter because such modification would provide the format conversion of Guck with the enhanced necessary to have a faster network communication or business process." (*See, e.g.*, final Office Action mailed April 15, 2004, Page 3-4) The Examiner's summary conclusion that it would have been obvious to those of ordinary skill in the art at the time of Applicants' invention to include "a faster protocol as taught by Slaughter" in "the format conversion of Guck" because this "would provide the format conversion of Guck with the enhanced necessary to have a faster network communication or business process" (*See, e.g.*, Office Action mailed October 28, 2003, Page 7; final Office Action mailed April 15, 2004, Pages 8-9) does not even appear to be relevant to Appellant's claimed invention and is certainly not supported by any teaching, suggestion, or motivation in *Guck*, *Slaughter*, or knowledge generally available to those of ordinary skill in the art at the time of Appellant's invention.

First, independent Claim 6 recites that "a first version of a business application," not "a user" as the Examiner states, exerts or relinquishes control over execution of the business process. Second, it is entirely unclear how use of a faster protocol, such as LLCL rather than TCP/IP, relates to the limitations recited in independent Claim 6. Third, if two applications are communicating in connection with a business process, the two applications would likely if not necessarily communicate with one another using the same protocol, such that allowing the application with the faster protocol to exert or relinquish control appears to make little if any sense in many, perhaps most, contexts. Fourth, it cannot be assumed that "a user with a faster protocol, should have control over the business process" and the Examiner provides no explanation or support as to why this should be the case. For example, it may be more desirable for the version of the business application having more, better, or newer collaboration functionality to exercise control, irrespective of the protocol it supports.

Appellant respectfully submits that the Examiner's purported motivation for combining *Guck* with *Slaughter* falls well short of the requirements set forth in the M.P.E.P. and governing Federal Circuit case law. Since the Examiner has not provided a sufficient teaching, suggestion, or motivation in the prior art, the Examiner's conclusion of obviousness is improper.

Moreover, even assuming for the sake of argument that *Slaughter* was analogous art and that there was the required suggestion or motivation to combine *Guck* with *Slaughter*, the proposed *Guck-Slaughter* combination still would not disclose the limitations specifically recited in Appellant's independent Claim 6 for at least the reasons explained above. This is true whether the proposed *Guck-Slaughter* combination is considered alone or in combination with information generally known to those skilled in the art at the time of the invention.

For at least these reasons, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of independent Claim 6 and its dependent claims. These claims are therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

For substantially similar reasons to those discussed above with reference to independent Claim 6, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of independent Claims 15, 25, and 44 and their dependent claims. These claims are therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

VI. Group 2 (Claims 2, 10-11, and 20-21)

Claims 2, 10-11, and 20-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these claims are clearly patentable over the proposed *Guck-Slaughter* combination. Thus, Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

Claims 2, 10-11, and 20-21 are separately patentable from every other claim subject to the same ground of rejection. These claims recite limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, these claims recite patentable distinctions over the prior art beyond those recited in independent Claims 6, 15, and 25.

Dependent Claims 2, 10-11, and 20-21 depend from independent Claims 6, 15, and 25, respectively, which Appellant has shown above to be clearly patentable over the proposed *Guck-Slaughter* combination, and are allowable for at least this reason. In addition, dependent Claims 2, 10-11, and 20-21 recite further patentable distinctions over the proposed *Guck-Slaughter* combination.

For example, applying the Examiner's reasoning with respect to dependent Claim 2 would require "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) to be operable to:

- (1) include a version identification module operable to generate a version identification request for communication to the second client, the version identification request being associated with enabling "an author to create and store an original document, as a source file with a first format" (which the Examiner applies against Appellant's recited business process) and generated according to a version identification protocol supported by both "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) and "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Appellant's recited second version of the single business application); and

- (2) allow a similar version identification module of "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Appellant's recited second version of the single business application) to initiate communication of the second version identifier to "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's

recited first version of the single business application) in response to the version identification request.

Quite simply, neither *Guck* nor *Slaughter* disclose, teach, or suggest such limitations. Indeed, as best as Appellant can deduce, the Examiner does not even indicate any portions of either *Guck* or *Slaughter* that purportedly disclose, teach, or suggest “a version identification module” of the first business application, “a version identification request,” “a version identification protocol,” or the various other limitations recited in Claim 2.

For at least these reasons, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claim 2. Claim 2 is therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

For substantially similar reasons to those discussed above with reference to dependent Claim 2, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claims 10-11 and 20-21. These claims are therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

VII. Group 3 (Claims 3, 12, and 22)

Claims 3, 12, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these claims are clearly patentable over the proposed *Guck-Slaughter* combination. Thus, Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

Claims 3, 12, and 22 are separately patentable from every other claim subject to the same ground of rejection. These claims recite limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, these claims recite

patentable distinctions over the prior art beyond those recited in independent Claims 6, 15, and 25.

Dependent Claims 3, 12, and 22 depend from independent Claims 6, 15, and 25, respectively, which Appellant has shown above to be clearly patentable over the proposed *Guck-Slaughter* combination, and are allowable for at least this reason. In addition, dependent Claims 3, 12, and 22 recite further patentable distinctions over the proposed *Guck-Slaughter* combination.

For example, applying the Examiner's reasoning with respect to dependent Claim 3 would require "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) to be operable to:

if "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) is an initiator of enabling "an author to create and store an original document, as a source file with a first format" (which the Examiner applies against Appellant's recited business process), control enabling "an author to create and store an original document, as a source file with a first format" (which the Examiner applies against Appellant's recited business process) if the second version is not higher than the first version.

Quite simply, neither *Guck* nor *Slaughter* disclose, teach, or suggest such limitations. Indeed, as best as Appellant can deduce, the Examiner does not even indicate any portions of either *Guck* or *Slaughter* that purportedly disclose, teach, or suggest even considering whether "the process of enabling an author to create and store an original document (which the Examiner applies against Appellant's recited first version of the single business application) "is an initiator of the business process," as recited in Claim 3.

For at least these reasons, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claim 3. Claim 3 is therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

For substantially similar reasons to those discussed above with reference to dependent Claim 3, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claims 12 and 22. These claims are therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

VIII. Group 4 (Claims 4, 13, and 23)

Claims 4, 13, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these claims are clearly patentable over the proposed *Guck-Slaughter* combination. Thus, Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

Claims 4, 13, and 23 are separately patentable from every other claim subject to the same ground of rejection. These claims recite limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, these claims recite patentable distinctions over the prior art beyond those recited in independent Claims 6, 15, and 25.

Dependent Claims 4, 13, and 23 depend from independent Claims 6, 15, and 25, respectively, which Appellant has shown above to be clearly patentable over the proposed *Guck-Slaughter* combination, and are allowable for at least this reason. In addition, dependent Claims 4, 13, and 23 recite further patentable distinctions over the proposed *Guck-Slaughter* combination.

For example, applying the Examiner's reasoning with respect to dependent Claim 4 would require "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) to:

include a business process module operable to (1) generate a first business message associated with enabling "an author to create and store an original document, as a source file with a first format" (which the Examiner applies against Appellant's recited business process) for communication to the second client, the first business message being generated according to the second version and (2) initiate retrieval from the second client of a second business message generated according to the second version.

Quite simply, neither *Guck* nor *Slaughter* disclose, teach, or suggest such limitations. Indeed, as best as Appellant can deduce, the Examiner does not even indicate any portions of either *Guck* or *Slaughter* that purportedly disclose, teach, or suggest a business process module operable to "generate a first business message associated with the business process for communication to the second client, the first business message being generated according to the second version" and "initiate retrieval from the second client of a second business message generated according to the second version," as recited in Claim 4.

For at least these reasons, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claim 4. Claim 4 is therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

For substantially similar reasons to those discussed above with reference to dependent Claim 4, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claims 13 and 23. These claims are therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

IX. Group 5 (Claims 5, 14, and 24)

Claims 5, 14, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these claims are clearly patentable over the proposed *Guck-Slaughter* combination. Thus, Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

Claims 5, 14, and 24 are separately patentable from every other claim subject to the same ground of rejection. These claims recite limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, these claims recite patentable distinctions over the prior art beyond those recited in independent Claims 6, 15, and 25.

Dependent Claims 5, 14, and 24 depend from independent Claims 6, 15, and 25, respectively, which Appellant has shown above to be clearly patentable over the proposed *Guck-Slaughter* combination, and are allowable for at least this reason. In addition, dependent Claims 5, 14, and 24 recite further patentable distinctions over the proposed *Guck-Slaughter* combination.

For example, applying the Examiner's reasoning with respect to dependent Claim 5 would require the first client to be operable to:

receive a status message from the second client indicating the presence of a business message associated with enabling "an author to create and store an original document, as a source file with a first format" (which the Examiner applies against Appellant's recited business process) at the second client, the status message being generated according to a status message protocol supported by both "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) and "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Appellant's recited second version of the single business application).

Quite simply, neither *Guck* nor *Slaughter* disclose, teach, or suggest such limitations. Indeed, as best as Appellant can deduce, the Examiner does not even indicate any portions of either *Guck* or *Slaughter* that purportedly disclose, teach, or suggest such a "status message," let alone "the first client is operable to receive a status message from the second client indicating the presence of a business message associated with the business process at the second client, the status message being generated according to a status message protocol supported by the first version of the business application and the second version of the business application," as recited in Claim 5

For at least these reasons, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claim 5. Claim 5 is therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

For substantially similar reasons to those discussed above with reference to dependent Claim 5, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claims 14 and 24. These claims are therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

X. Group 6 (Claim 7, 16, and 26)

Claims 7, 16, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these claims are clearly patentable over the proposed *Guck-Slaughter* combination. Thus, Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

Claims 7, 16, and 26 are separately patentable from every other claim subject to the same ground of rejection. These claims recite limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, these claims recite patentable distinctions over the prior art beyond those recited in independent Claims 6, 15, and 25.

Dependent Claims 7, 16, and 26 depend from independent Claims 6, 15, and 25, respectively, which Appellant has shown above to be clearly patentable over the proposed *Guck-Slaughter* combination, and are allowable for at least this reason. In addition, dependent Claims 7, 16, and 26 recite further patentable distinctions over the proposed *Guck-Slaughter* combination.

For example, applying the Examiner's reasoning with respect to dependent Claim 7 would require "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) to:

include a business process module operable to generate a business message associated with enabling "an author to create and store an original document, as a source file with a first format" (which the Examiner applies against Appellant's recited business process) for retrieval by the second client, the business message being generated according to the first version.

Quite simply, neither *Guck* nor *Slaughter* disclose, teach, or suggest such limitations.

For at least these reasons, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claim 7. Claim 7 is therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

For substantially similar reasons to those discussed above with reference to dependent Claim 7, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claims 16 and 26. These claims are therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

XI. Group 7 (Claims 8, 17, and 27)

Claims 8, 17, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these claims are clearly patentable over the proposed *Guck-Slaughter* combination. Thus, Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

Claims 8, 17, and 27 are separately patentable from every other claim subject to the same ground of rejection. These claims recite limitations that are substantially different from

limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, these claims recite patentable distinctions over the prior art beyond those recited in independent Claims 6, 15, and 25.

Dependent Claims 8, 17, and 27 depend from independent Claims 6, 15, and 25, respectively, which Appellant has shown above to be clearly patentable over the proposed *Guck-Slaughter* combination, and are allowable for at least this reason. In addition, dependent Claims 8, 17, and 27 recite further patentable distinctions over the proposed *Guck-Slaughter* combination.

For example, applying the Examiner's reasoning with respect to dependent Claim 8 would require "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) to:

include a status message module operable to generate a status message for communication to the second client to indicate the presence of a business message associated with enabling "an author to create and store an original document, as a source file with a first format" (which the Examiner applies against Appellant's recited business process) at the first client, the status message being generated according to a status message protocol supported by both "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) and "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Appellant's recited second version of the single business application).

Quite simply, neither *Guck* nor *Slaughter* disclose, teach, or suggest such limitations. Indeed, as best as Appellant can deduce, the Examiner does not even indicate any portions of either *Guck* or *Slaughter* that purportedly disclose, teach, or suggest "a status message module," let alone "the first version of the business application further comprises a status message module operable to generate a status message for communication to the second client to indicate the presence of a business message associated with the business process at the first client, the status message being generated according to a status message protocol

supported by the first version of the business application and the second version of the business application,” as recited in Claim 8.

For at least these reasons, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claim 8. Claim 8 is therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

For substantially similar reasons to those discussed above with reference to dependent Claim 8, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claims 17 and 27. These claims are therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

XII. Group 8 (Claims 29, 34, and 39)

Claims 29, 34, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these claims are clearly patentable over the proposed *Guck-Slaughter* combination. Thus, Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

Claims 29, 34, and 39 are separately patentable from every other claim subject to the same ground of rejection. These claims recite limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, these claims recite patentable distinctions over the prior art beyond those recited in independent Claims 6, 15, and 25.

Dependent Claims 29, 34, and 39 depend from independent Claims 6, 15, and 25, respectively, which Appellant has shown above to be clearly patentable over the proposed *Guck-Slaughter* combination, and are allowable for at least this reason. In addition,

dependent Claims 29, 34, and 39 recite further patentable distinctions over the proposed *Guck-Slaughter* combination.

For example, applying the Examiner's reasoning with respect to dependent Claim 29 would require either *Guck* or *Slaughter* to disclose, teach, or suggest that "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) is higher than "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Appellant's recited second version of the single business application) if "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) is one or more of:

- (1) more robust than "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Appellant's recited second version of the single business application);
- (2) more advanced than "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Appellant's recited second version of the single business application); and
- (3) capable of providing enhanced functionality or services, relative to "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Appellant's recited second version of the single business application), in performing the business process.

Appellant respectfully submits that, not only does the above make little if any sense, but the above is very plainly not disclosed, taught, or suggested by either *Guck* or *Slaughter*. Indeed, as best as Appellant can deduce, the Examiner does not even indicate any portions of either *Guck* or *Slaughter* that purportedly disclose, teach, or suggest the limitations recited in Claim 29.

For at least these reasons, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claim 29. Claim 29 is therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

For substantially similar reasons to those discussed above with reference to dependent Claim 29, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claims 34 and 39. These claims are therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

XIII. Group 9 (Claims 30, 35, and 40)

Claims 30, 35, and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these claims are clearly patentable over the proposed *Guck-Slaughter* combination. Thus, Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

Claims 30, 35, and 40 are separately patentable from every other claim subject to the same ground of rejection. These claims recite limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, these claims recite patentable distinctions over the prior art beyond those recited in independent Claims 6, 15, and 25.

Dependent Claims 30, 35, and 40 depend from independent Claims 6, 15, and 25, respectively, which Appellant has shown above to be clearly patentable over the proposed *Guck-Slaughter* combination, and are allowable for at least this reason. In addition, dependent Claims 30, 35, and 40 recite further patentable distinctions over the proposed *Guck-Slaughter* combination.

For example, applying the Examiner's reasoning with respect to dependent Claim 30 would require either *Guck* or *Slaughter* to disclose, teach, or suggest that "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) exhibits backward compatibility with "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Appellant's recited second version of the single business application), "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) being capable of performing the business process according to either "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) or the "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Appellant's recited second version of the single business application).

Appellant respectfully submits that, not only does the above make little if any sense, but the above is very plainly not disclosed, taught, or suggested by either *Guck* or *Slaughter*. Indeed, as best as Appellant can deduce, the Examiner does not even indicate any portions of either *Guck* or *Slaughter* that purportedly disclose, teach, or suggest the limitations recited in Claim 30, including any such backward compatibility.

For at least these reasons, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claim 30. Claim 30 is therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

For substantially similar reasons to those discussed above with reference to dependent Claim 30, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claims 35 and 40. These claims are therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

XIV. Group 10 (Claims 31, 36, and 41)

Claims 31, 36, and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these claims are clearly patentable over the proposed *Guck-Slaughter* combination. Thus, Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

Claims 31, 36, and 41 are separately patentable from every other claim subject to the same ground of rejection. These claims recite limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, these claims recite patentable distinctions over the prior art beyond those recited in independent Claims 6, 15, and 25.

Dependent Claims 31, 36, and 41 depend from independent Claims 6, 15, and 25, respectively, which Appellant has shown above to be clearly patentable over the proposed *Guck-Slaughter* combination, and are allowable for at least this reason. In addition, dependent Claims 31, 36, and 41 recite further patentable distinctions over the proposed *Guck-Slaughter* combination.

For example, dependent Claim 31 recites that “the first business application of the first client can be upgraded from the first version to a higher version without negatively impacting any other clients in the system.” Appellant respectfully submits that these limitations are very plainly not disclosed, taught, or suggested by either *Guck* or *Slaughter*. Indeed, as best as Appellant can deduce, the Examiner does not even indicate any portions of either *Guck* or *Slaughter* that purportedly disclose, teach, or suggest the limitations recited in Claim 31.

For at least these reasons, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claim 31. Claim 31 is therefore patentable over the

proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

For substantially similar reasons to those discussed above with reference to dependent Claim 31, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claims 36 and 41. These claims are therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

XV. Group 11 (Claims 32, 37, and 42)

Claims 32, 37, and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these claims are clearly patentable over the proposed *Guck-Slaughter* combination. Thus, Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

Claims 32, 37, and 42 are separately patentable from every other claim subject to the same ground of rejection. These claims recite limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, these claims recite patentable distinctions over the prior art beyond those recited in independent Claims 6, 15, and 25.

Dependent Claims 32, 37, and 42 depend from independent Claims 6, 15, and 25, respectively, which Appellant has shown above to be clearly patentable over the proposed *Guck-Slaughter* combination, and are allowable for at least this reason. In addition, dependent Claims 32, 37, and 42 recite further patentable distinctions over the proposed *Guck-Slaughter* combination.

For example, applying the Examiner's reasoning with respect to dependent Claim 32 would require either *Guck* or *Slaughter* to disclose, teach, or suggest that "the process of enabling an author to create and store an original document" (which the Examiner applies

against Appellant's recited first version of the single business application) and "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Appellant's recited second version of the single business application) each exhibit bidirectional executability in that each can execute enabling "an author to create and store an original document, as a source file with a first format" (which the Examiner applies against Appellant's recited business process) that it did no itself initiate.

Appellant respectfully submits that, not only does the above make little if any sense, but the above is very plainly not disclosed, taught, or suggested by either *Guck* or *Slaughter*. Indeed, as best as Appellant can deduce, the Examiner does not even indicate any portions of either *Guck* or *Slaughter* that purportedly disclose, teach, or suggest the limitations recited in Claim 30, including any such bidirectional executability.

For at least these reasons, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claim 32. Claim 32 is therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

For substantially similar reasons to those discussed above with reference to dependent Claim 32, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claims 37 and 42. These claims are therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

XVI. Group 12 (Claims 33, 38, and 43)

Claims 33, 38, and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these claims are clearly patentable over the proposed *Guck-Slaughter* combination. Thus, Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

Claims 33, 38, and 43 are separately patentable from every other claim subject to the same ground of rejection. These claims recite limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, these claims recite patentable distinctions over the prior art beyond those recited in independent Claims 6, 15, and 25.

Dependent Claims 33, 38, and 43 depend from independent Claims 6, 15, and 25, respectively, which Appellant has shown above to be clearly patentable over the proposed *Guck-Slaughter* combination, and are allowable for at least this reason. In addition, dependent Claims 33, 38, and 43 recite further patentable distinctions over the proposed *Guck-Slaughter* combination.

For example, applying the Examiner's reasoning with respect to dependent Claim 33 would require either *Guck* or *Slaughter* to disclose, teach, or suggest that "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) is higher than "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Appellant's recited second version of the single business application) if "the process of enabling an author to create and store an original document" (which the Examiner applies against Appellant's recited first version of the single business application) is one or more of:

- (1) the first client is associated with a buyer enterprise;
- (2) the second client is associated with a seller enterprise
- (3) enabling "an author to create and store an original document, as a source file with a first format (which the Examiner applies against Appellant's recited business process) comprises an order purchasing business process;
- (4) the first business message comprises a purchase order; and
- (5) the second business message comprises a purchase order acknowledgement

Appellant respectfully submits that, not only does much of the above make little if any sense, but the above is very plainly not disclosed, taught, or suggested by either *Guck* or *Slaughter*. Indeed, as best as Appellant can deduce, the Examiner does not even indicate any portions of either *Guck* or *Slaughter* that purportedly disclose, teach, or suggest many of the limitations recited in Claim 33.

For at least these reasons, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claim 33. Claim 33 is therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

For substantially similar reasons to those discussed above with reference to dependent Claim 33, the proposed *Guck-Slaughter* combination fails support the obviousness rejection of dependent Claims 38 and 43. These claims are therefore patentable over the proposed *Guck-Slaughter* combination. Appellant respectfully submits that these rejections are improper and should be reversed by the Board.

Conclusion

Appellant has demonstrated that the present invention, as claimed, is clearly patentably distinguishable over the prior art cited by the Examiner. Therefore, Appellant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a Notice of Allowance of all pending claims.

Appellant has enclosed a check in the amount of \$330.00 for this Appeal Brief and a check in the amount of \$420.00 for the cost of a two-month extension of time for filing the Appeal Brief. Although Appellant believes no other fees are due, the Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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Appendix A

2. The system of Claim 6, wherein the first version of the business application comprises a version identification module operable to generate a version identification request for communication to the second client, the version identification request being associated with the business process and generated according to a version identification protocol supported by the first version of the business application and the second version of the business application, a version identification module of the second version of the business application initiating communication of the second version identifier to the first version of the business application in response to the version identification request.

3. The system of Claim 6, wherein the first version of the business application is operable, if the first version of the business application is an initiator of the business process, to control the business process if the second version is not higher than the first version.

4. The system of Claim 6, wherein the first version of the business application further comprises a business process module operable to:

generate a first business message associated with the business process for communication to the second client, the first business message being generated according to the second version; and

initiate retrieval from the second client of a second business message generated according to the second version.

5. The system of Claim 6, wherein the first client is operable to receive a status message from the second client indicating the presence of a business message associated with the business process at the second client, the status message being generated according to a status message protocol supported by the first version of the business application and the second version of the business application.

A.2

6. A system for performing a business process, comprising:
a first version of a business application identified using a first version identifier and executable by a first client to perform a business process, the first client being coupled to a second client using a communication link, a second version of the business application identified using a second version identifier being executable by the second client to perform the business process;

the first version of the business application operable to determine the first version identifier and the second version identifier and, if the first version is higher than the second version, to exercise control over execution of the business process;

the first version of the business application operable to allow the second version of the business application to exercise control over execution of the business process if the second version is higher than the first version.

7. The system of Claim 6, wherein the first version of the business application further comprises a business process module operable to generate a business message associated with the business process for retrieval by the second client, the business message being generated according to the first version.

8. The system of Claim 6, wherein the first version of the business application further comprises a status message module operable to generate a status message for communication to the second client to indicate the presence of a business message associated with the business process at the first client, the status message being generated according to a status message protocol supported by the first version of the business application and the second version of the business application.

10. The method of Claim 15, further comprising:
generating a version identification request for communication from the first client to the second client; and
receiving the second version identifier from the second client in response to the version identification request.

A.3

11. The method of Claim 10, wherein the version identification request is generated according to a version identification protocol that is supported by the first version of the business application and the second version of the business application.

12. The method of Claim 15, further comprising, if the first version of the business application is an initiator of the business process, controlling the business process at the first client if the second version is not higher than the first version.

13. The method of Claim 15, further comprising:
generating a first business message associated with the business process for communication from the first client to the second client, the first business message being generated according to the second version; and
retrieving from the second client a second business message generated by the second client according to the second version.

14. The method of Claim 15, further comprising:
at the first client, receiving a status message generated by the second client according to a status message protocol that is supported by the first version of the business application and the second version of the business application, the status message indicating the presence of a business message associated with the business process at the second client; and
retrieving the business message from the second client in response to the status message.

A.4

15. A method for performing a business process, comprising:
at a first client, determining a first version identifier associated with a first version of a business application used by the first client to perform a business process;
at the first client, determining a second version identifier associated with a second version of the business application used by a second client to perform the business process;
at the first client, exercising control over execution of the business process if the first version is higher than the second version; and
at the first client, allowing the second version of the business application to exercise control over execution of the business process if the second version is higher than the first version.

16. The method of Claim 15, further comprising generating at the first client a business message associated with the business process for retrieval by the second client, the business message being generated according to the second version.

17. The method of Claim 15, further comprising communicating a status message from the first client to the second client according to a status message protocol supported by the first version of the business application and the second version of the business application, the status message indicating the presence of a business message associated with the business process at the first client.

18. The method of Claim 15, further comprising:
performing the business process according to the first version if the second version is higher than the first version; and
performing the business process according to the second version if the first version is higher than the second version.

20. The software of Claim 25, further operable to:
generate a version identification request for communication from the first client to the second client; and
receive the second version identifier from the second client in response to the version identification request.

A.5

21. The software of Claim 20, wherein the version identification request is generated according to a version identification protocol that is supported by the first version of the business application and the second version of the business application.

22. The software of Claim 25, further operable to, if the first version of the business application is an initiator of the business process, control the business process at the first client if the second version is not higher than the first version.

23. The software of Claim 25, further operable to:
generate a first business message associated with the business process for communication from the first client to the second client, the first business message being generated according to the second version; and
retrieve from the second client a second business message generated by the second client according to the second version.

24. The software of Claim 25, further operable to:
at the first client, receive a status message generated by the second client according to a status message protocol that is supported by the first version of the business application and the second version of the business application, the status message indicating the presence of a business message associated with the business process at the second client; and
retrieve the business message from the second client in response to the status message.

A.6

25. Software for performing a business process, the software being encoded on a computer-readable medium and when executed operable to:

at a first client, determine a first version identifier associated with a first version of a business application used by the first client to perform a business process;

at the first client, determine a second version identifier associated with a second version of the business application used by a second client to perform the business process;

at the first client, exercise control over execution of the business process if the first version is higher than the second version; and

at the first client, allow the second version of the business application to exercise control over execution of the business process if the second version is higher than the first version.

26. The software of Claim 25, further operable to generate at the first client a business message associated with the business process for retrieval by the second client, the business message being generated according to the second version.

27. The software of Claim 25, further operable to communicate a status message from the first client to the second client according to a status message protocol supported by the first version of the business application and the second version of the business application, the status message indicating the presence of a business message associated with the business process at the first client.

28. The software of Claim 25, further operable to:
perform the business process according to the first version if the second version is higher than the first version; and
perform the business process according to the second version if the first version is higher than the second version.

A.7

29. The system of Claim 6, wherein the first version is higher than the second version if the first version is one or more of:

more robust than the second version;

more advanced than the second version; and

capable of providing enhanced functionality or services, relative to the second version, in performing the business process.

30. The system of Claim 6, wherein the first version of the business application exhibits backward compatibility with the second version of the business application, the first version of the business application being capable of performing the business process according to either the first version or the second version.

31. The system of Claim 6, wherein the first business application of the first client can be upgraded from the first version to a higher version without negatively impacting any other clients in the system.

32. The system of Claim 6, wherein the first and second versions of the business application each exhibit bidirectional executability in that each can execute a business process that it did not itself initiate.

33. The system of Claim 6, wherein:

the first client is associated with a buyer enterprise;

the second client is associated with a seller enterprise;

the business process comprises an order purchasing business process;

the first business message comprises a purchase order; and

the second business message comprises a purchase order acknowledgement.

A.8

34. The method of Claim 15, wherein the first version is higher than the second version if the first version is one or more of:

more robust than the second version;

more advanced than the second version; and

capable of providing enhanced functionality or services, relative to the second version, in performing the business process.

35. The method of Claim 15, wherein the first version of the business application exhibits backward compatibility with the second version of the business application, the first version of the business application being capable of performing the business process according to either the first version or the second version.

36. The method of Claim 15, wherein the first business application of the first client can be upgraded from the first version to a higher version without negatively impacting any other clients in the system.

37. The method of Claim 15, wherein the first and second versions of the business application each exhibit bidirectional executability in that each can execute a business process that it did not itself initiate.

38. The method of Claim 15, wherein:

the first client is associated with a buyer enterprise;

the second client is associated with a seller enterprise;

the business process comprises an order purchasing business process;

the first business message comprises a purchase order; and

the second business message comprises a purchase order acknowledgement.

A.9

39. The software of Claim 25, wherein the first version is higher than the second version if the first version is one or more of:

- more robust than the second version;
- more advanced than the second version; and
- capable of providing enhanced functionality or services, relative to the second version, in performing the business process.

40. The software of Claim 25, wherein the first version of the business application exhibits backward compatibility with the second version of the business application, the first version of the business application being capable of performing the business process according to either the first version or the second version.

41. The software of Claim 25, wherein the first business application of the first client can be upgraded from the first version to a higher version without negatively impacting any other clients in the system.

42. The software of Claim 25, wherein the first and second versions of the business application each exhibit bidirectional executability in that each can execute a business process that it did not itself initiate.

43. The software of Claim 25, wherein:

- the first client is associated with a buyer enterprise;
- the second client is associated with a seller enterprise;
- the business process comprises an order purchasing business process;
- the first business message comprises a purchase order; and
- the second business message comprises a purchase order acknowledgement.

A.10

44. A system for performing a business process, comprising:

means for, at a first client, determining a first version identifier associated with a first version of a business application used by the first client to perform a business process;

means for, at the first client, determining a second version identifier associated with a second version of the business application used by a second client to perform the business process; and

means for, at the first client, exercising control over execution of the business process if the first version is higher than the second version; and

means for, at the first client, allowing the second version of the business application to exercise control over execution of the business process if the second version is higher than the first version.